



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/604,985

08/29/2003

Itzhak Bentwich

050992(0200CPUS12)

1984

37808

7590

07/26/2006

ROSETTA-GENOMICS

c/o PSWS

700 W. 47TH STREET

SUITE 1000

KANSAS CITY, MO 64112

EXAMINER

WOLLENBERGER, LOUIS V

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,985	BENTWICH, ITZHAK	
	Examiner	Art Unit	
	Louis V. Wollenberger	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) 1,4 and 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5,7-9 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Exhibits A, B, C, D.</u> |

DETAILED ACTION

Election/Restrictions

Applicants' timely election, with traverse, of Group II, Claims 2, 5, 7-9, and 17-21, in the reply filed on 6/23, 2006, is acknowledged.

Applicant traverses the restriction between Groups I and II; however, Applicant does not distinctly and specifically point out the supposed errors in the restriction requirement as it relates to the two inventions: Groups I and II.

Instead, Applicant's arguments are directed to claims 19-21. Applicant argues that claims 19-21 should be considered to be linking claims in that claims 19-21 link inventions I and II.

Applicants' arguments have been fully considered but are not found persuasive.

As Applicant notes, MPEP §809 states, in part, that

“Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.”

However, in the instant case, as explained below, it cannot be determined what exactly Applicant is seeking to claim in the elected claims. Consequently, it cannot be determined whether claims 19-21, in fact, are generic to the inventions of Groups I and II, because it cannot be determined whether one or more of claims 19-21 meet the requirements of a generic claim.

MPEP §806.04(d) defines a generic claim as follows:

“In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

In general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim.”

Thus, while claims 19-21 may read on either DNA or RNA, it is not readily apparent that both claim 4 and claim 5, for example, which belong to Groups I and II, respectively, require all of the limitations of each of claims 19-21.

The analysis of a generic-species relationship among the pending claims is further complicated by the fact that claim 1, the base claim, is indefinite, as explained below.

The Examiner submits, therefore, that the original claim set was properly restricted among independent and distinct inventions and that no generic claims are present in the application.

The requirement is still deemed proper and is therefore made FINAL.

Status of the application

Claims 1, 2, 4, 5, and 7-21 are pending. Claims 1, 4, and 10-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 2, 5, 7-9, and 17-21 are examined herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 5, 7-9, and 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are rejected as being indefinite for two reasons:

First, the claims depend from a withdrawn claim, claim 1. Because claim 1 is currently not under consideration, since it has been withdrawn as being drawn to a non-elected invention, the invention, with all of its limitations, claimed in claims 2, 5, 7-9, and 17-21 cannot be properly examined.

Second, even if claim 1 were under consideration, claim 1 is indefinite for the following reason. Claim 1 recites "An isolated nucleic acid comprising the sequence of SEQ ID NO:1, wherein the nucleic acid is from about 91 to about 120 nucleotides." A review of the instant application and CRF, shows that SEQ ID NO:1 is a 131-nucleotide DNA sequence (see Exhibit A: A copy of page 1 of a sequence search of SEQ ID NO:1 in the EST database).

Thus, it is unclear how any nucleic acid may "comprise" SEQ ID NO:1 and be about 91 to about 120 nucleotides long. A nucleic acid sequence comprising SEQ ID NO:1 must be at least 131-nucleotides long.

Accordingly, in view of the indefiniteness of claim 1, it cannot be determined what Applicant is seeking to claim in claims 2, 5, 7-9, and 17-21, which, directly or indirectly, all depend from claim 1.

The instant claims are, therefore, rejected as being indefinite.

Prior Art not Relied Upon but Made of Record

The following prior art is made of record and is not relied upon, but is considered pertinent to applicant's disclosure.

A search of SEQ ID NO:1 against the commercial nucleic acid databases finds a 766-base pair cDNA sequence comprising SEQ ID NO:1 that was published online at the NCBI Website on Feb. 20, 1998 (See Exhibits B and C: Printouts from the NCBI website for Accession number AA878312). The sequence, corresponding to GenBank Accession No. AA878312, is said to represent a human cDNA clone similar to tyrosine-protein kinase receptor EPH precursor mRNA (see Exhibit B). The Office's sequence search computer program shows that GenBank Accession No. AA878312 comprises SEQ ID NO:1 in its entirety (see Exhibit D: nucleic acid alignment and search result #1 in the EST database).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis V. Wollenberger whose telephone number is 571-272-8144. The examiner can normally be reached on Mon–Fri, 8:00 am–4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Peter Paras, can be reached at telephone number 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval system (PAIR). Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

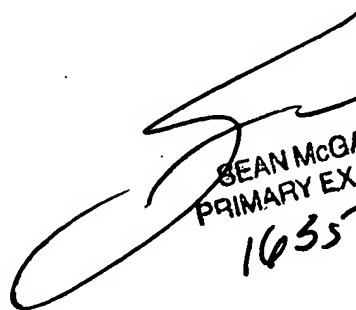
applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

July 13, 2006

Louis V. Wollenberger, Ph.D.
Examiner
Art Unit 1635


SEAN MCGARRY
PRIMARY EXAMINER
1635